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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/240,410	01/29/99	MICHALOVICH	D GP-30039

EXAMINER

HM12/0623

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CLASSER, J	PAPER NUMBER
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1641

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DATE MAILED:

06/23/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS*Restrict/Elect. only* OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 1-12 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 12, drawn to a polypeptides, classified in class 530, subclass 350, for example.
 - II. Claims 2 and 6-8, 10 and 11, drawn to a polynucleotides, host cells and portions of said host cells and , classified in class 536, subclass 23.7, for example.
 - III. Claim 3, drawn to an antibody, classified in class 530, subclass 387.1, for example.
 - IV. Claim 4, drawn to a process for diagnosing disease using by analyzing the nucleic acid encoding a protein, classified in class 435, subclass 6, for example.
 - V. Claim 5, drawn to a method of screening compounds which inhibit or stimulate the function of a polypeptide, classified in class 435, subclass 32, for example.
 - VI. Claim 9, drawn to a membrane of a host cell, classified in class 424, subclass 184.1, for example, for example.

2. The inventions are distinct, each from the other because of the following reasons:

Groups I-III and VI are drawn to different products. The claims of Group I are drawn to a polypeptides, the claims Group II are drawn to a polynucleotides, Group III is drawn to an antibody and Group VI is drawn to a membrane. The inventions can be shown to be distinct because they are made by different methods and because they are physically, structurally and functionally distinct chemical entities. Note: it is unclear if Applicants are intending to claim a

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non-purified polypeptide in claim 9, such as a membrane preparation consisting essentially of the polypeptide, or a host cell or a heterogeneous composition comprising the polypeptide in a membrane. Applicants should clarify what is being claimed in the response to the Restriction Requirement so that it can be determined if claim 9 should be re-grouped with the host cells of Group II or the polypeptides of Group I or remain in its own Group.

Inventions II and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotides of Group II may be used for purposes other than in diagnosing disease, i.e., they may be used to overexpress a protein, or in hybridization assays, etc..

Inventions I and V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptides of Group I may be used for purposes other than in screening compounds, i.e., they may be used as immunogens in treatment methods and/or to generate antibodies. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as

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shown by their different classification, and because the literature search for Groups I-VI would not be coextensive, restriction for examination purposes as indicated is proper.


2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

3. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Graser whose telephone number is (703) 308-1742. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.


JENNIFER GRASER
JENNIFER GRASER
PATENT EXAMINER